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Pierre Tequi

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7245

34014 7590 04/30/2008

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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. The rejections of claims 1-2 and 4-23 are maintained for the reasons of record.
2. Applicant argues that there is no motivation to combine Li with Dickey and De Vries, because the compositions of Li already have superior lubricity and therefore it would not be obvious to modify anything in Li. Applicant's argument fails to appreciate the fact that the composition of Li already contains boron nitride, and that Dickey and De Vries are simply being used to determine which species and size of boron nitride will give the best lubricating performance. No ingredients are being added or subtracted from the composition of Li. Given that boron nitride comes in many shapes and sizes, it would have been entirely rational for one of ordinary skill in the art to look to the teachings of Dickey and De Vries to determine the preferred type, and one would have had a reasonable expectation of success in doing so.
3. Applicant makes the same arguments regarding the combination of the Dickey and De Vries references with Pacholke, which the examiner disagrees with for the same reasons stated in paragraph 2 above. Applicant also argues that Pacholke teaches away from the use of dispersant or non-dispersant methacrylates, and therefore is not properly combined with Papay. Before addressing this argument, it is noted that Papay also discloses dispersant olefin copolymers, as discussed in paragraph 3 of the office action mailed 1/10/08, and that the argument regarding methacrylates would not overcome the rejections of claims 1 and 9 even if it were valid. Pacholke does teach in

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Table 1 (Example 7) that a methacrylate copolymer is not a suitable stabilizer. However, the methacrylates of Papay are used as viscosity index improvers, not stabilizers.

Stability will be imparted by the copolymers of Pacholke.

JCG

/Glenn A Caldarola/

Acting SPE of Art Unit 1797